

## Question Q217

**National Group:** Panamanian Group

**Title:** The patentability criterion of inventive step / non-obviousness

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**Date:** April 7, 2011

### Questions

#### I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

#### Level of inventive step / non-obviousness

1. *What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?*

The standard for inventive step / non-obviousness in Panama does not follow a formalized approach. However the Patent Office does take into consideration that the invention would no result obvious to a skilled person.

The definition of inventive step / non-obviousness in our jurisdiction is the following: "if it is not obvious or derived in an evident way off the state of the art, for a person well versed in the corresponding technical matter."

2. *Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?*

Prior to the adoption of Law No. 35 of May 10, 1996, most of the inventions protected in Panama were under revalidation patents, therefore the Patent Office did not formalize any standards related to inventive steps /non-obviousness in our country.

3. *Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?*

No, the Panamanian Patent Office does not publish examination guidelines on inventive step / non-obviousness.

4. *Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?*

The standard for inventive step /non-obviousness should not differ during examination, litigation or invalidity proceedings since all of them are based on the same legal basis, even if the litigations in country are tried under the specialized Commercial Courts.

Notwithstanding the above, we must mention that there is no precedent of a judicial trial in our country based on lack of inventive step / non-obviousness that may support this fact.

### **Construction of claims and interpretation of prior art**

5. *How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?*

Our jurisdiction establishes that claims must be construed of an introduction followed by a characterization. Claims are read literally.

6. *Is it possible to read embodiments from the body of the specification into the claims?*

No, our law provides that it is not possible to read embodiments from the body of the specification into the claims.

7. *How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?*

The prior art is interpreted as would be understood by a person skilled in the art.

8. *Do the answers to any of the questions above differ during examination versus during litigation?*

No, the base is the same during both of the instances.

### **Combination or modification of prior art**

9. *Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?*

Yes, a single prior art reference may be used as basis to find lack of inventive step of obviousness. However, according to our law the invention will be granted regardless the result of the state-of-the-art of the invention and without taking into account objections that may be raised by third parties.

In view of the above, no arguments or reference to common general knowledge may be necessary to invoke, unless a cancellation action is filed and tried before the competent Circuit Courts. In this last case, if the claim is novel over the prior art reference, we are of the opinion that both, arguments and the level of the common general knowledge would be take into consideration.

10. *What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?*

That the result of the combination maintains the novelty and the inventive step required by our law to obtain the protection of the invention. No there is not explicit teaching or motivation to combine required.

11. *When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?*

It would not have any relevance if what is claimed maintains the novelty and inventive step requested by our law. The important fact is that the prior art references combined does not eliminate or make evident the lack of inventive step.

On the other hand, the problem the inventor of the claim in question was trying to solve does not have any relevance regarding the lack of inventive step.

12. *Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?*

Yes is it permitted. No, the standard is not different from when only two references are combined.

13. *Do the answers to any of the questions above differ during examination versus during litigation?*

No, it would be maintained in both scenarios.

### **Technical Problem**

14. *What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?*

That it does not result obvious for a person skilled in the art.

15. *To what degree, if any, must the technical problem be disclosed or identified in the specification?*

To describe entirely what is contained in the claims to the point that a person skilled in the art may be able to reproduce the invention.

### **Advantageous effects**

16. *What role, if any, do advantageous effects play in determining inventive step or non-obviousness?*

None.

17. *Must the advantageous effects be disclosed in the as-filed specification?*

Yes if their content is included in the abstract of the invention.

18. *Is it possible to have later-submitted data considered by the Examiner?*

Yes by filing an amendment of the original application.

19. *How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?*

The advantageous effects must be real and sustained if they are cited within the abstract of the invention. If they are only hypothetical they must be explained in that way in the case.

20. *Do the answers to any of the questions above differ during examination versus during litigation?*

No it will be maintained the same in both instances.

### Teaching away

21. *Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?*

No.

22. *Among the other factors supporting inventive step / non-obviousness, how important is teaching away?*

It is not considered within the factors in favor of inventive step / non-obviousness.

23. *Is there any difference in how teaching away is applied during examination versus in litigation?*

No.

### Secondary considerations

24. *Are secondary considerations recognized in your jurisdiction?*

Yes, secondary use is recognized under patentability in our jurisdiction.

25. *If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?*

The use of a known product or procedure to obtain a different and not known result.

In the same way as if the original product and result has been proven.

In the secondary use it will be the connection between the original claimed invention, with the inclusion of the new unknown result.

26. *Do the answers to any of the questions above differ during examination versus during litigation?*

No.

### Other considerations

27. *In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?*

No.

*If yes, please describe these issues, tests, or factors.*

## Test

28. *What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.*

The definition of inventive step / non-obviousness in our jurisdiction is the following, which correspond to the specific statement of the test for inventive step 7 non-obviousness: "if it is not obvious or derived in an evident way off the state of the art, for a person well versed in the corresponding technical matter."

No, there is no jurisprudence or other authoritative literature interpreting the meaning of such test.

29. *Does such test differ during examination versus during litigation?*

No.

## Patent granting authorities versus courts

30. *If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.*

No.

31. *Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?*

No.

## Regional and national patent granting authorities

32. *If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?*

No, we do not have two patent granting authorities covering our jurisdiction.

33. *If yes, is this problematic?*

No.

## II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. *Is harmonization of inventive step / non-obviousness desirable?*

Yes it would be very helpful.

35. *Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?*

Yes, but it will be very helpful to base this standard base on criteria that represent benefits for industrialized and non-industrialized countries.

36. *Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.*

Our proposition will stand with the Panamanian Patent Law, to wit: "if it is not obvious or derived in an evident way of the state of the art, for a person skilled in the corresponding technical matter."

37. *Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.*

As it is clearly understood from the definition stated above, that a person skilled in the corresponding technical matter determines that what it is claimed it is not obvious nor derived in an evident way of the state-of-the-art of the invention which protection is sought.